

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Douglas S. Reeves et al.

Serial No. 09/691,347

Filed: 10/18/2000

For: **AUTHORIZING COMMUNICATION SERVICES**

Examiner: Shin, Kyung H.

Art Unit: 2143

Mail Stop Appeal Brief – Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

A **REPLY BRIEF** is filed herewith. If any fees are required in association with this reply brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

## **REPLY BRIEF**

### **A. Introduction**

Appellant argued in its Appeal Brief that claims 1-14, 20-29, and 33-36 are patentable for two reasons: (1) the combination of Eriksson and Chang fails to disclose each and every element of the pending claims; and (2) the combination of Eriksson and Chang is improper. In particular, the combination of Eriksson and Chang fails to teach or suggest the use of the claimed authentication indicia. The claimed authentication data is configured to enable reservation of resources for communication, and is sent to at least one of the originating and destination terminals to facilitate reservation of resources. The authentication indicia is subsequently sent to at least one network element to reserve resources for at least a portion of the communication. Neither Eriksson nor Chang teach the use of the claimed authentication indicia.

In addition to failing to teach or suggest each and every element of the claimed invention, there is no motivation to combine the references of Eriksson and Chang to arrive at the claimed invention. Eriksson uses ticket messages as proof of prior resource reservations and uses these ticket messages to transmit packets through a network. There is no use of authentication indicia to enable the intermediate elements of the network to reserve resources for a communication session. This is because there is no need to reserve the resources because the resources have already been reserved for the communication. Chang is focused on the resources at the respective communication terminals and is not concerned about reserving resources at the intermediate nodes within the network. The respective references have different focuses and there is really no need to combine the references.

For the above reasons, claims 1-14, 20-29, and 33-36 are non-obvious. Appellant incorporates by reference the arguments set forth in its Appeal Brief in its entirety. In addition, Appellant responds to certain points raised by the Patent Office in the Examiner's Answer.

### **B. Argument**

In response to Appellant's arguments that the ticket message of Eriksson is not equivalent to the claimed authentication indicia (see Appeal Brief filed July 10, 2006, pp. 9-10), the Patent Office responds by stating that resource reservation is well known in the art and that the authentication indicia is merely information transmitted between network nodes with resource

reservation information. The Patent Office further states that, as the authentication indicia is transmitted along the communications path, the resources are reserved. The Patent Office then asserts that Eriksson “discloses an equivalent function which reserves initial resources and realtime modifications along a communication path.” (Examiner’s Answer mailed October 10, 2006, p. 15).

First, Appellant notes that the test for obviousness is not whether the prior art discloses an equivalent function. See MPEP § 2114 (a prior art device can perform all the functions of the claimed invention and still not render the claim unpatentable if there are structural differences). The prior art must show each limitation of the claim. MPEP § 2143.03; *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1974) (“All words in a claim must be considered in judging the patentability of that claims against the prior art.”). The claims of the present invention require that the authentication indicia be “configured to enable reservation of resources for the communication.” In addition, the claimed authentication indicia is initially sent to at least one of the originating and destination terminals to facilitate reservation of resources for the communication, wherein the at least one of the originating and destination terminals receiving the authorization indicia will subsequently send the authorization indicia to at least one network element to reserve resources for at least a portion of the communication. Thus, the prior art must show that the authentication indicia is what is used to reserve the resources for the communication.

The Patent Office has asserted that the ticket message of Eriksson is equivalent to the claimed authentication indicia. However, as previously set forth in the Appeal Brief, Eriksson shows that resources are reserved first and then a ticket message is sent to provide information indicating that the resources have been reserved (See Appeal Brief filed July 10, 2006, pp. 9-10). Therefore, the Patent Office’s statement on page 15 of the Examiner’s Answer that “as the authentication indicia is transmitted along the communications path, the resources are reserved” is simply not true in Eriksson. The ticket message in Eriksson is simply proof that resources have already been reserved. By the time the ticket message is received, the resources have already been reserved. Thus, in Eriksson, the ticket message is not “configured to enable reservation of resources for the communication,” as required by the claimed invention. Thus, Eriksson does not teach or suggest each and every claim element. Chang does not cure the deficiencies of Eriksson. Since neither Eriksson nor Chang, alone or in combination, teach or suggest each and every claim element, the claims are allowable.

In the Examiner's Answer, the Patent Office also argues that Eriksson discloses the capability to send a request for communication (i.e., resource reservation) from a remote network node and that the capability exists for the sender network node to receive a ticket message (reserve resources information), and that the request is equivalent to the claimed authentication indicia (Examiner's Answer mailed October 10, 2006, pp. 15-16). First, Appellant notes that a mere capability of the prior art is insufficient to actually teach a claim element. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) ("the mere fact that a certain thing may result from a given set of circumstances is insufficient"). Second, the Patent Office is inconsistent with what it asserts teaches the claimed authentication indicia. The Patent Office has previously asserted in the Office Action mailed November 16, 2005 (see p. 5) that the ticket message of Eriksson was the claimed authentication indicia and now the Patent Office seemingly asserts in the Examiner's Answer that the request for resource reservation is the claimed authentication indicia. In any event, the request for resource reservation cannot be the claimed authentication indicia. The claimed invention recites receiving a request for authorization to establish a communication with a destination terminal from an origination terminal. Eriksson discloses a request to reserve resources; it does not teach or suggest a request for authorization to establish a communication. In addition, the claimed invention also recites that the authorization indicia be configured to enable reservation of resources for the communication. The request for resource reservation in Eriksson does not actually enable the reservation of resources, as the claimed authentication indicia does. Thus, the request for resource reservation in Eriksson cannot be the claimed authentication indicia, and the claims are therefore allowable.

The Patent Office also raises the point that Eriksson discloses the capability for resource reservation from any network node along the communication path (Examiner's Answer mailed October 10, 2006, p. 16). Even assuming this is true, it is not relevant to whether Eriksson discloses the claimed authentication indicia. There must be authentication indicia generated and sent that is "configured to enable reservation of resources for the communication," as required by the claimed invention. Eriksson fails to teach or suggest any such authentication indicia (See Appeal Brief filed July 10, 2006, pp. 9-11). Eriksson may teach resource reservation, but it is not using the claimed authentication indicia.

Appellant previously argued that the ticket message of Eriksson cannot be the claimed authentication indicia because in Eriksson, the resources are first reserved and then the ticket

message is sent to provide information that the resources have been reserved. Therefore, the ticket message cannot be configured to enable reservation of resources since the resources were already reserved. The Patent Office responds by stating that the resource reservation can be modified as the communications session is active and cites to Chang, col. 2, lines 37-34 (sic) (Examiner's Answer mailed October 10, 2006, p. 16). First, any alleged teaching in Chang is irrelevant to whether the ticket message in Eriksson can be the claimed authentication indicia. Second, it is clear that Eriksson does not teach the claimed authentication indicia. It is clear in Eriksson that the resources have already been reserved before the ticket message M1 is sent to merely providing information indicating that the resources have been reserved (see Eriksson, col. 3, lines 40-44). Upon receipt of the ticket message M1, each packet sent to the terminating terminal within a given time period includes the ticket message M1. Each packet is sent through the access router and the real-time routers, which require the packet to have the ticket message to pass. (Eriksson, col. 4, lines 4-11). The ticket message of Eriksson is simply proof that resources have already been reserved. The access router and the real-time routers do not reserve resources based on the ticket message. When the ticket message is received, the resources have already been reserved. Therefore, the ticket message of Eriksson is not "configured to enable reservations of resources," as is the claimed authentication indicia. Nothing in Chang cures the deficiencies of Eriksson (see Appeal Brief filed July 10, 2006, pp. 10-11).

As set forth above, the combination of Eriksson and Chang does not teach or suggest the claimed invention. In particular, the Patent Office has failed to show a *prima facie* case that the combination teaches or suggests the claimed authentication indicia. Instead, the Patent Office mischaracterizes what is claimed in the present invention by paraphrasing the claims and ignoring specific claim elements and claim language. For example, in the Conclusion section of the Examiner's Answer, the Patent Office states that "Applicant's invention claims a capability for the reservation of network resources along a communications path between a source and a destination node. In addition, the destination node sends a response back to the source node (i.e. upstream node), that the resources have been reserved. In addition, applicant's invention claims the capability to modify the reserved resources during the communication session." (Examiner's Answer mailed October 10, 2006, p. 17). Appellant's claims do not recite a "capability." Appellant's claims do not use the language that "the destination node sends a response back to the source node (i.e. upstream node), that the resources have been reserved." Appellant's claims

do not use the language “ to modify the reserved resources during the communication session.” Most notably in the Patent Office’s mischaracterization of what is claimed by Appellant, there is no mention of the claimed authentication indicia, which is configured to enable the reservation of the resources and is requested, generated, and sent. Essentially, what the Patent Office is attempting to do is characterize what the Patent Office believes is taught by the prior art, and then inaccurately assert the same thing is being claimed in the claims of the present invention. However, this ignores the plain meaning of the claim language, which includes the claimed authentication indicia. Appellant does not claim the mere capability to reserve resources, but specifically claims authentication indicia to be configured to enable the reservation of the resources. As set forth above, the combination of Eriksson and Chang does not teach or suggest using **authentication indicia** to enable the reservation of the resources, and thus the claims are allowable.

### C. Conclusion

In conclusion, the combination of Eriksson and Chang fails to teach or suggest the use of authentication indicia, which is configured to enable the reservation of resources for communication. Also, the combination of Eriksson and Chang is improper. As such, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons.

Respectfully submitted,

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